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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,192	10/12/2005	Francisco Javier Romero Amaya	11474.0NEW	1285

26712 7590 01/08/2008

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EXAMINER	
SCHLIENTZ, NATHAN W	
ART UNIT	**PAPER NUMBER**
1616	

MAIL DATE	DELIVERY MODE
01/08/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/537,192	ROMERO AMAYA, FRANCISCO JAVIER	
	Examiner	Art Unit	
	Nathan W. Schlientz	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 June 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/ are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6/2/05,11/23/05,2/2/06,2/15/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

Claims 1-17, filed 02 June 2005, are pending and thus examined herein on the merits for patentability. No claim is allowed at this time.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1, 6, 9-12, 14, 16 and 17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-20 of copending Application No. 10/537,148 (U.S. Patent Application Publication No. 2007/0074640). Although the conflicting claims are not identical, they are not

patentably distinct from each other because both sets of claims are drawn to a method for preserving wood, i.e. timber product, comprising administering to the wood product bifenthrin. The concentration of bifenthrin within the wood products overlap (i.e. 23 g/m^3 or more), and the bifenthrin composition in both sets of claims include a carrier (i.e. glue). Therefore, the scope of the copending claims overlap and thus they are obvious variants of one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The instant claim recites, "the product retains *significant insecticide/acaracide properties* above 25 degrees centigrade." However, the instant specification does not adequately define what is meant by *significant insecticide/acaracide properties*. Therefore, the instant claim is confusing with respect to the metes and bounds of the claim limitations.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 2, 6, 10-12, 14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,747,519 (Kodama et al.).

Kodama et al. disclose a composition comprising a compound of formula (I) and a pyrethroid compound, such as bifenthrin, which is applied to wood by spraying to control termites (col. 1, ll. 32-42; col. 2, ll. 6-10 and 38-40; col. 3, ll. 21-24, 27-45; and claim 11). Kodama et al. further disclose the use of auxiliary agents and liquid vehicles (col. 3, ll. 46-67). Kodama et al. also disclose examples of compositions comprising bifenthrin for the treatment of wood, such as timber products like plywood, particle boards and half boards (col. 4, ll. 13-20; Embodiments 1 and 2 in Examples; and Table 1). Therefore, Kodama et al. clearly disclose treating wood, such as timber or all kinds of wood, by impregnating the wood with bifenthrin.

With respect to the retention of significant insecticide/acaracide properties above 25 °C, the timber product of Kodama et al. comprises the same components as the instant claims and therefore would inherently possess significant insecticide/acaracide properties above 25 °C. The examiner respectfully points out the following from MPEP 2112: "The discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old

composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). In *In re Crish*, 393 F.3d 1253, 1258, 73 USPQ2d 1364, 1368 (Fed. Cir. 2004), the court stated that "just as the discovery of properties of a known material does not make it novel, the identification and characterization of a prior art material also does not make it novel."

2. Claims 1, 2, 6, 8, 10-12, 14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by CA 2 321 353 (Wimmer et al.).

Wimmer et al. disclose a wood preservative comprising a cyclodextrin, tebuconazole, propiconazole and ***bifenthrin*** (page 4, 2nd and 3rd paragraphs; page 14, Example 7; page 15, Example 8; and claims 10 and 11). Wimmer et al. further disclose a method of protecting wood and timber materials by treating said wood or timber with the preservative composition comprising bifenthrin (claim 18). Also, Wimmer et al. disclose that the wood preservative may also comprise colorants(page 6, line 21; and claim 15), and may be applied to wood by known means, such as painting on, spraying or impregnating methods such as dipping, immersing, and pressure (page 9, 3rd paragraph).

With respect to the retention of significant insecticide/acaracide properties above 25 °C, the same argument under Kodama et al. applies here as well.

3. Claims 1, 6, 10-12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 11-207706 (Takahide et al.).

Takahide et al. disclose an antiseptic insecticide for wood comprising a wood antiseptic and insecticide, such as bifenthrin, diluted with water (Abstract). Therefore, Takahide et al. disclose applying an antiseptic insecticide comprising bifenthrin to wood.

With respect to the retention of significant insecticide/acaracide properties above 25 °C, the same argument under Kodama et al. applies here as well.

4. Claims 1, 2, 6, 7 and 9-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Shires et al., The International Research Group on Wood Preservation, 19-24 May 1996 (Shires et al.).

Shires et al. disclose bifenthrin as a suitable wood preservative (Title). Shires et al. disclose treating Scots pine sapwood (*Pinus sylvestris L.*) and beech wood (*Fagus sylvatica L.*) with a light organic solvent product (LSOP) by spraying with a pipette or micro emulsion concentrate by dipping and double vacuum comprising bifenthrin and a ceresblue dye (Section 2.1), as well as applying the bifenthrin composition by brushing (Section 2.2). Shires et al. further disclose a superficial treatment of the pine and beech wood with the LSOP composition comprising bifenthrin which gives a loading of 3.5 to 14.5 g/m^3 bifenthrin at a depth of 3 mm (Section 3.1 and Table 2).

With respect to the retention of significant insecticide/acaracide properties above 25 °C, the same argument under Kodama et al. applies here as well.

5. Claims 1, 9-14 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Creffield et al., The International Research Group on Wood Preservation, 12-17 May 2002 (Creffield et al.).

Creffield et al. disclose treating *P. radiate* sapwood specimens to a nominal retention of 2.5, 5, 10, 15, 20, 30 and 50 g/m^3 of bifenthrin with white spirit used as the solvent (page 3, Field Trial; and Tables 1 and 2).

With respect to the retention of significant insecticide/acaracide properties above 25 °C, the same argument under Kodama et al. applies here as well.

With respect to the timber product of instant claim 13 comprising *about* 4 g/m^3 bifenthrin, Creffield et al. disclose 2.5 and 5 g/m^3 of bifenthrin. Therefore, Creffield et al. clearly envisaged the retention of *about* 4 g/m3 bifenthrin within the sapwood specimen.

6. Claims 1, 6, 10-12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 1 018 413 (Jaetsch et al.).

Jaetsch et al. disclose insecticidal treatment of the backside of plywood with bifenthrin, nonyphenol, formalinchatcher, water, and other solvents (page 7). Therefore, Jaetsch et al. disclose a method of treating timber with bifenthrin as well as the timber product comprising bifenthrin.

With respect to the retention of significant insecticide/acaracide properties above 25 °C, the same argument under Kodama et al. applies here as well.

7. Claims 1, 2, 6, 10-12, 14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,536,305 (Yu).

Yu discloses applying bifenthrin to freshly sawn timber via pressure treatment, vacuum treatment, dipping, brushing, spraying, or soaking (col. 2, ll. 4-7 and 13; col. 4, ll. 26-34; and claims 1-5). Yu further discloses that surfactants, adjuvants including antifoam agents, antifreeze agents, wetting agents, thickeners, and the like can be added to composition, as well as organic solvents (col. 2, ll. 17-18, 34-35, and 52-59; and claims 2 and 3).

With respect to the retention of significant insecticide/acaracide properties above 25 °C, the same argument under Kodama et al. applies here as well.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1,148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Kodama et al., Wimmer et al., Shires et al., and Yu, as applied to the claims discussed above, in view of U.S. Patent No. 4,894,262 (Heitmanek).

Applicant claims:

Applicants claim a method of timber preservation by spraying bifenthrin on the timber product at a sawmill with a linear sprayer after stress grading and a second spray with a transverse sprayer after a docker saw operation.

Determination of the scope and content of the prior art

(MPEP 2141.01)

Kodama et al. teach applying bifenthrin to timber for termite control, as discussed above.

Wimmer et al. teach applying bifenthrin as a wood preservative to timber materials to protect against wood-discoloring and wood-destroying fungi and insects, as discussed above.

Shires et al. teach spraying, dipping, and superficially treating sapwood and beech wood with bifenthrin compositions to protect against wood destroying insects, as discussed above.

Yu teaches applying bifenthrin to freshly sawn timber products via spraying, as discussed above.

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Kodama et al., Wimmer et al., Shires et al., and Yu do not teach spraying the timber with bifenthrin at a sawmill with a linear sprayer after stress grading and a second spray with a transverse sprayer after a docker saw operation. However, it is commonly known in the art that the use of stress-graded timber is for structural use, it is a critical safety element of construction and the use of strength-graded timber is required by Building Regulations. Also, Heitmanek teaches treating lumber by spraying at the sawmill to seal the sides and ends to maintain the moisture content of the wood (col. 1, ll. 10-55).

Finding of *prima facie* obviousness

Rational and Motivation (MPEP 2142-43)

Therefore, it would have been *prima facie* obvious for one skilled in the art at the time of the invention to apply the bifenthrin composition to the timber product of Kodama et al., Wimmer et al., Shires et al., and Yu while the timber product is at the sawmill and has been stress graded and freshly cut by a docker saw in order to seal/protect the sides and the ends, as reasonably taught by Heitmanek. Also, one of ordinary skill in the art would want to apply the bifenthrin preservative after cutting with a docker as opposed to prior to cutting with the docker saw in order to prevent exposing unprotected portions of the timber.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed

invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

2. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kodama et al., Wimmer et al., Shires et al., Creffield et al., Jaetsch et al., and Yu, as applied to the claims as discussed above, in view of U.S. Patent No. 2,892,261 (Hutchinson).

Applicant claims:

Applicants claim a method of timber product preservation comprising applying bifenthrin to the timber product while the product is warmer than room temperature.

Determination of the scope and content of the prior art

(MPEP 2141.01)

Kodama et al. teach applying bifenthrin to timber for termite control, as discussed above.

Wimmer et al. teach applying bifenthrin as a wood preservative to timber materials to protect against wood-discoloring and wood-destroying fungi and insects, as discussed above.

Shires et al. teach spraying, dipping, and superficially treating sapwood and beech wood with bifenthrin compositions to protect against wood destroying insects, as discussed above.

Creffield et al. teach applying bifenthrin to sapwood specimens for protection against termites, as discussed above.

Jaetsch et al. teach applying bifenthrin to the backside of plywood for anti-insecticide properties, as discussed above.

Yu teaches applying bifenthrin to freshly sawn timber products via spraying, as discussed above.

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Kodama et al., Wimmer et al., Shires et al., Creffield et al., Jaetsch et al., and Yu do not teach heating the timber product prior to treating with bifenthrin. However, Hutchinson teaches a process for drying and preserving lumber and simultaneously rendering the same water-resistant, flame-resistant and resistant to pests such as termites and the like, wherein the temperature of the lumber is increased in order to open the pores of the wood to condition it for subsequent treatment with insecticides, dyes, etc. (col. 1, ll. 15-17, 31-34 and 63-66; and col. 2, ll. 54-57). Hutchinson further teaches spraying the lumber with a hot fluid on all sides until the load of lumber is completely submerged in the treating medium (col. 3, ll. 54-56).

Finding of *prima facie* obviousness

Rational and Motivation (MPEP 2142-43)

Therefore, it would have been *prima facie* obvious for one skilled in the art at the time of the invention to heat the timber product of Kodama et al., Wimmer et al., Shires et al., Creffield et al., Jaetsch et al., and Yu prior to treatment with bifenthrin in order to open the pores of the wood to condition it for the subsequent treatment, as reasonably taught by Hutchinson.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan W. Schlientz whose telephone number is 571-272-9924. The examiner can normally be reached on 8:30 AM to 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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